

REMARKS

I. Status and Disposition of the Claims

In the instant application, claims 1-36, of which claims 1, 7, 12, 16, 21, 24, 26, 30, and 33 are independent, are pending and under consideration on the merits.

In the Office Action mailed April 27, 2009¹, the following actions were taken:

1) claims 1-6 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; and

2) claims 1-36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pat. No. US 4,773,009, by Kucera et al. (hereinafter "*Kucera*") in view of Pat. No. US 7,343,308, by Rojewski et al. (hereinafter "*Rojewski*").

II. Interview Summary

Applicant thanks Examiner Le for the courtesies extended in granting and conducting a telephone interview on July 8, 2009 with the undersigned, student associate, Ceyda A. Maisami, and counsel for Applicant, Brad Pruitt. The substance of the interview is summarized herein.

During the interview on July 8, 2009, Applicant's representatives described the claimed invention. Further, Applicant's representatives presented proposed claim

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

amendments that had been attached to the Applicant Initiated Interview Request Form.

The Examiner indicated that, for claim 1, the proposed amendments would overcome the 35 U.S.C. § 112. Moreover, the Examiner indicated that the proposed amendments were on the right track and helpful. However, the Examiner reserved the right to further search the subject matter considering the proposed amendments.

Also, the Examiner and Applicant's representatives discussed the use of positive recitation of specific elements in claim 1.

No agreement was reached but Applicant's representatives indicated that they would submit the proposed amendments in an official Office Action response, and the Examiner agreed to consider them.

III. Amendments to the Claims

In this Amendment and Response, Applicant amends claims 1, 3, 7, 12, 14-16, 21, 23, 24, and 26-36. The amendments are not made to distinguish the claims over the prior art of record, but rather to clarify the subject matter sought to be patented. Many of the claims have been amended to improve readability, to more distinctly claim the subject matter, and to bring the pending claims into condition for allowance. Support for amendments for the pending claims can be found, for example, at paragraphs [029], [032] and [033] of the Specification.

Moreover, Applicant cancels claims 2, 5, 13, and 22.

IV. Response to Rejections

Applicant respectfully traverses the rejections listed above, and requests that the rejections of claims 1-6 under 35 U.S.C. § 112 and claims 1-36 under 35 U.S.C. § 103(a) be withdrawn.

A. The Rejection of the Claims under 35 U.S.C. § 112 should be withdrawn.

In the pending Office Action, claims 1-6 were rejected under 35 U.S.C. § 112, second paragraph, "for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Office Action at 3. Further, the Office Action asserted, "it is not clear what is doing the 'determining' step in claim 1." *Id.*

While Applicant disagrees with the Office Action's characterization of the claims, to advance prosecution and to tie the method therein recited more closely to a specific machine, Applicant has amended claim 1 to recite, *inter alia*, "determining, **by a score analyzer**, if the insurance claim has subrogation potential." (Emphasis added)

Accordingly, Applicant respectfully requests withdrawal of the rejection of independent claim 1 and claims 3, 4, and 6, which depend from claim 1, under 35 U.S.C. § 112.

B. The Rejection of the Claims under 35 U.S.C. § 103(a) should be withdrawn.

In the pending Office Action, claims 1-36 were rejected under 35 U.S.C. § 103(a).

i. Standard for the Rejection of Claims under 35 U.S.C. § 103(a)

"The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. §103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007) held that "[t]here is no necessary inconsistency between the idea underlying the TSM [teaching, suggestion, motivation] test and the *Graham* analysis." M.P.E.P. § 2141 (rev. 6, Sept. 2007), citing *KSR* at 82 U.S.P.Q. 2d at 1396. Applicant understands this to mean that when applicable, as here, TSM reasoning may still be applied not only by an examiner but also by Applicant to refute a 35 U.S.C. § 103 rejection.

ii. **Claims 1-36**

Claims 1-36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kucera* in view of *Rojewski*. Applicant respectfully disagrees with this rejection, but to further prosecution, amends claim 1 to read, "**identifying, by a text analyzer using a specialized insurance dictionary, insurance data elements** in text associated with an insurance claim." (Emphasis added) This amendment further explains how insurance claim text is analyzed in Applicant's system.

Nowhere in *Rojewski* is there a suggestion or teaching of identifying insurance data elements, nor using a specialized insurance dictionary to do so. *Rojewski* mentions identifying subrogation opportunities by analyzing claim data. See *Rojewski* at col. 2, lines 50-59. However, this is not analogous to identifying insurance data elements using a specialized insurance dictionary. *Rojewski* doesn't identify insurance data elements, with a subrogation opportunity or not, nor does it use a specialized insurance dictionary. Therefore, *Rojewski* does not teach the above cited element of Applicant's claim 1.

Kucera does not make up for *Rojewski*'s deficiency because *Kucera* does not teach "identifying . . . using a specialized insurance dictionary, insurance data elements in text associated with an insurance claim." *Kucera* does not use a specialized insurance dictionary. Therefore, *Kucera* cannot identify terms or phrases specific to a specialized field such as insurance. For example, *Kucera* would not know to identify insurance terms such as "percent fault" or "coverage code" or "payment type." See, in contrast, Specification at para. [038]. Since *Kucera* splits sentences and tokens into words and punctuations, it would split such terms or phrases into individual words such

as "percent" and "fault" in the example of "percent fault." See *Kucera* at col. 5, line 54 - col. 6, line 29. Therefore, *Kucera* does not teach the above cited element of Applicant's claim 1.

Moreover, Applicant canceled claim 2, and incorporated it into claim 1. Claim 1 requires, *inter alia*, "storing, by the text analyzer, the extracted insurance data elements in data tables corresponding to the insurance claim." Applicant submits that the above mentioned recitation is not taught by any of the cited prior art references.

The Office Action confirms that "Kucera does not expressly teach storing the extracted data elements in data tables corresponding to the insurance claim." Office Action at 5. However, the Office Action asserts that "this is well known in the art as evidenced by *Rojewski*." The Office Action continues, "*Rojewski* teaches claim files stored in the data warehouse." Office Action at 5 (citing *Rojewski*, col. 3, lines 3-20.)

Rojewski's col. 3, lines 3-20 refers to *Rojewski* Fig. 5, which illustrates compiling, valuing and selling subrogation rights. See *Rojewski* at col. 3, lines 4-5. However, nowhere in this citation or elsewhere in *Rojewski* is there a suggestion of "storing, by the text analyzer, the extracted insurance data elements in data tables corresponding to the insurance claim." First of all, *Rojewski*'s claim files are not analogous to Applicant's extracted insurance data elements. Second of all, *Rojewski*'s data warehouse is not necessarily data tables as disclosed in Applicant's application. Finally, *Rojewski* does not have a text analyzer to extract and store any extracted data elements in tables. Therefore, *Rojewski* does not teach the above cited claim element.

For at least the foregoing reasons, amended claim 1 and related dependent claims 3, 4 and 6 are allowable under 35 U.S.C. § 103(a).

Although of different scope, independent claims 7, 12, 16, 21, 24, 26, 30, and 33 recite similar features and thus also are allowable for at least the same reasons as amended claim 1. For at least the reasons stated above with respect to claims 7, 12, 16, 21, 24, 26, 30, and 33, the rejection of claims 8-11, 14-15, 17-20, 23, 25, 27-29, 31-32, and 34-36 which depend from claims 7, 12, 16, 21, 24, 26, 30, and 33, are also allowable.

Therefore, Applicant respectfully requests the rejection under 35 U.S.C. § 103(a) of all of the pending claims to be withdrawn.

V. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: 

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